

THIS DISPOSITION IS NOT
CITABLE AS PRECEDENT OF THE TTAB JUNE 18, 99
U.S. DEPARTMENT OF COMMERCE
PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Ing. C. Olivetti & C., S.p.A.

Serial No. 75/039,580

Donna M. Weinstein of Fish & Richardson. P. C. for Ing. C.
Olivetti & C., S.p.A.

Anne Madden, Trademark Examining Attorney, Law Office 102
(Thomas Shaw, Managing Attorney).

Before Seeherman, Walters and Wendel, Administrative
Trademark Judges.

Opinion by Wendel, Administrative Trademark Judge:

Ing. C. Olivetti & C., S.p.A. has filed an application
to register the mark OLIVETTI ENVISION for "computers;
personal and portable computers; keyboards for computers;
electrical power supplies; computer disk drives; blank
streaming tapes; apparatus for reading and recording data
on magnetic and optical supports, namely, blank
magnetically encoded and optical cards and discs, boards

and cards having microprocessors, readers and recorders for said boards and cards; devices for reproduction of sound and images, namely, video controllers, fax/modem boards."¹

Registration has been finally refused under Section 2(d) of the Trademark Act, on the ground of likelihood of confusion with the registered mark ENVISION for "computer hardware, namely, color video display stations."² Applicant and the Examining Attorney have filed briefs, but no oral hearing was requested.

The Examining Attorney maintains that the likelihood of confusion exists on the basis of the similarity of the marks, the similarity of the goods and the similarity of the channels of trade.

Insofar as the goods are concerned, the Examining Attorney argues that the goods of registrant and applicant are closely related computer goods which could be used together. She has made of record third-party registrations showing that computer goods of both types may emanate from a single source. Applicant, on the other hand, has offered no argument with respect to any distinction between the

¹ Serial No. 75/039,580, filed January 2, 1996, under Section 44(e), with a claim of priority under Section 44(d), based on Italian application TO 95C002185 filed July 6, 1995, which matured into Reg. No. 657043 on September 22, 1995.

² Registration No. 1,425,518, issued January 20, 1987; Section 8 and 15 affidavit filed and accepted.

goods. Accordingly, we go forward with our analysis with the apparently undisputed conclusion that the goods are closely related computer products and would travel in the same channels of trade.

The question is whether applicant's addition of its house mark OLIVETTI is sufficient to distinguish the registered mark ENVISION from applicant's mark OLIVETTI ENVISION. Applicant contends that the mark ENVISION is highly suggestive as used with video-oriented computers and, accordingly, applicant's well-known house mark is the dominant portion of its mark and serves to make the likelihood of confusion remote. Applicant supports its argument of suggestiveness with copies of fourteen third-party registrations for the mark ENVISION, or phonetic equivalents thereof, for use in connection with various computer products.

The Examining Attorney maintains that the registered mark ENVISION is not a weak mark; that the third-party registrations are not evidence of use by others of ENVISION marks; and that, even if considered, most of the third party registrations are restricted to computer software for limited purposes, and are not for computer hardware, as is involved here. The Examining Attorney further argues that the addition of the OLIVETTI house mark to registrant's

mark would simply would be likely to create confusion as to the source of registrant's goods.

As a general rule, the addition of a house mark to one of two otherwise confusingly similar marks will not serve to avoid the likelihood of confusion between them. In re Christian Dior, S.A., 225 USPQ 533 (TTAB 1985); In re C.F. Hathaway Co., 190 USPQ 343 (TTAB 1976). In fact, the addition may actually be an aggravation of the likelihood of confusion, rather than a distinguishing factor. Exceptions are made to this general rule, however, if there are some recognizable differences in the conflicting product marks, or if the product marks are merely descriptive or highly suggestive or play upon commonly used or registered terms, so that the addition of the house mark may be sufficient to render the marks as a whole distinguishable. See In re Christian Dior, S. A., *supra*, and the cases cited therein.

Here the ENVISION portion of applicant's mark is identical to registrant's mark. Accordingly, the first exception is not applicable.

There is no evidence that the term "envision" is merely descriptive of computer products, or more particularly, of registrant's video display stations. Thus, contrary to applicant's arguments, this is not a

situation similar to that in *In re S. D. Fabrics, Inc.*, 223 USPQ 54 (TTAB 1984) in which the additional presence in the registered mark of the house mark DAN RIVER was considered sufficient to distinguish the mark from applicant's merely descriptive mark "designers/fabric."

As for being highly suggestive, the dictionary definitions introduced by both the Examining Attorney and applicant define the word "envision" as "to picture in the mind" or "to picture to oneself." Such a connotation is at the most somewhat suggestive of the visualization function of registrant's display stations, or monitors.

While applicant has introduced evidence that ENVISION or its phonetic equivalent has been registered as a mark by several other entities for products in the computer field, these registrations do not persuade us that the term "envision" is highly suggestive in the field of computer hardware. Of the fourteen registrations made of record, only six are for the mark ENVISION, rather than a distinct phonetic variation, and these six are for use in connection with specific software programs, not hardware.

Nor can we accept the argument that these third-party registrations evidence "wide-spread use" of the mark ENVISION for closely related goods. Third-party registrations are not evidence of use of the marks shown

therein, or even that consumers are familiar with the marks so as to be accustomed to the existence of similar marks in the marketplace. See *Hilson Research Inc. v. Society for Human Resource Management*, 27 USPQ2d 1423 (TTAB 1993) and the cases cited therein. Thus, there is no reason for finding registrant's mark ENVISION so limited in trademark significance that the addition of applicant's house mark OLIVETTI would avoid any likelihood of confusion.

Instead, we believe this to be a case in which the fame being stressed by applicant for its OLIVETTI house mark only increases the likelihood of confusion when the house mark is added to what is, in effect, registrant's mark ENVISION. In view of the close relationship of registrant's ENVISION video display stations to the OLIVETTI ENVISION computer products of applicant, and the likelihood that both would be encountered by the same purchasers, these purchasers might well assume that applicant is in some way associated with, or now produces, registrant's goods. See *In re Riddle*, 225 USPQ 630 (TTAB 1985)[persons encountering automotive testing equipment sold under the mark ACCUTUNE and RICHARD PETTY'S ACCUTUNE automotive service centers would be likely to believe that Richard Petty was associated with both the goods and the services, in that both contain the designation ACCUTUNE].

Although applicant attempts to liken its situation to that in *Playboy of Miami, Inc. v. John B. Stetson Co.*, 426 F.2d 394, 165 USPQ 686 (CCPA 1970), no such parallel can be drawn. There, the Court found that STETSON was the dominant portion of opposer's mark THE STETSON PLAYBOY, and would suggest a type of hat. Applicant's mark PLAYBOY OF MIAMI, on the other hand, was not seen to have any single dominant feature. Thus, when the marks were considered in their entireties, the Court held them sufficiently different to avoid the likelihood of confusion. Here no such distinction can be made between ENVISION when used as registrant's entire mark and as the second half of applicant's mark. The word is the same and creates the same commercial impression in each mark.

Accordingly, we find that the use by applicant of its mark OLIVETTI ENVISION for its computer goods is likely to result in confusion on the part of purchasers, in view of the previously registered mark ENVISION for related goods. If there were any doubt in our minds, this too would be resolved in favor of registrant, as the prior user of the ENVISION mark. See *Giant Food Inc. v. Nation's Foodservice, Inc.*, 710 F.2d 1565, 218 USPQ 390 (Fed. Cir. 1983).

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Decision: The refusal to register under Section 2(d)
is affirmed.

E. J. Seeherman

C. E. Walters

H. R. Wendel
Trademark Administrative Judges,
Trademark Trial and Appeal Board

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